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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,493	10/13/2000	Sung Sik Jang	45475-00028 99-44653	9392

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EXAMINER

WILLIAMS, ALEXANDER O

ART UNIT PAPER NUMBER

2826

DATE MAILED: 10/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/687,493

Applicant(s)

JANG

Examiner

Alexander O Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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Serial Number: 09/687493 Attorney's Docket #: 45475-00028

Filing Date: 10/13/00; claimed foreign priority to 10/15/99

Applicant: Jang

Examiner: Alexander Williams

Applicant's Response/Substitute Specification in Paper # 11, filed 7/10/02 has been acknowledged.

The amendment to the claims filed on 7/10/02 does not comply with the requirements of 37 CFR 1.121(c) because in claims 1, 8 and 15, Applicant's improperly amended the claims for replacing "circumference" and inserting --perimeter--.

Amendments to the claims filed after March 1, 2001 must comply with 37 CFR 1.121(c) which states:

(c) Claims.

(1) Amendment by rewriting, directions to cancel or add: Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Since the reply filed on 7/10/02 appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this

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notice, whichever is longer, within which to submit an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Therefore, the amendment to the claims **have not been** acknowledged and/or entered.

The disclosure is objected to because of the following informalities: The listed application should be updated with application numbers and/or patent numbers.

Appropriate correction is required.

Correction is required.

The amendment filed 7/10/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: page 7, lines 29-30; page 7, lines 33-35; and page 9, lines 7-8.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 1 to 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, 8, and 15, it is unclear and confusing to what is meant by "a semiconductor chip having an upper surface, a circumference and a bottom surface." The semiconductor chip does not appear to be a part of circle.

Any of claims 1 to 20 not specifically addressed above are rejected as being dependent on one or more of the claims which have been specifically objected to above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Initially, and with respect to claims 6, 13 and 20, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hira, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear.

Claims 1 to 4, 6 to 11, 13 to 18 and 20, **insofar as they can be understood**, are rejected under 35 U.S.C. § 103(a) as being unpatentable over by Glenn et al. (U.S. Patent # 6,281,568 B1).

For example, Glenn et al. (figures 2 to 16) specifically figures 2 and 10 show a package semiconductor **60**, comprising: a semiconductor chip **52** having an upper surface, a circumference and a bottom surface; a plurality of input bond pads **53** and output bond pads **53** on said upper surface along said circumference electrically connected to said semiconductor chip **52**; a leadframe having a chip paddle **22**, said chip paddle being bonded to said semiconductor chip by an adhesive (inherent), said leadframe having a plurality of tie bars **23**, said plurality of tie bars **28** each having a side surface and a bottom surface, said plurality of tie bars externally extending from said chip paddle **22**, said leadframe having a plurality of dam bars **29**; a plurality of leads **31** connected to said leadframe; a plurality of wires **54** electrically connected to said plurality of leads and said semiconductor chips; encapsulation material

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encapsulating said semiconductor chip, said plurality of conductive wires, said chip paddle, and said plurality of internal leads 63 to form a package body 51; wherein said chip paddle has a plurality of through holes in said half etched section of said chip paddle for increasing the bonding strength of said encapsulating material in said package body. Glenn et al. fail to explicitly show the tie bars being connected to said corners of said chip paddle. However, Glenn et al. does disclose tie bars 28 connected to the chip paddle 23.

Therefore, it would have been obvious to one of ordinary skill in the art to use the teaching Glenn et al.'s tie bars for the purpose of providing support to the leadframe.

As to the grounds of rejection under section 103, see MPEP § 2113.

Response

Applicant's arguments filed 7/16/02 have been fully considered, but are moot in view of the new grounds of rejections detailed above.

The listed references are cited as of interest to this application, but not applied at this time.

Field of Search	Date
U.S. Class and subclass: 257/666,675,676,684,692,693,696,698,706,707,711- 713,717,720,734,730,787,796	1/12/02 10/12/02
Other Documentation: foreign patents and literature in 257/666,675,676,684,692,693,696,698,706,707,711- 713,717,720,734,730,787,796	1/12/02 10/12/02
Electronic data base(s): U.S. Patents EAST	1/12/02 10/12/02

Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. Papers should be faxed to Technology Center 2800 via the Technology Center 2800 Fax center located in Crystal Plaza 4-5B15. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 2800 Fax Center number is (703) 308-7722 or 24. Only Papers related to Technology Center 2800 APPLICATIONS SHOULD BE FAXED to the GROUP 2800 FAX CENTER.

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Any inquiry concerning this communication or any earlier communication from the examiner should be directed to **Examiner Alexander Williams** whose telephone number is **(703) 308-4863**.

Any inquiry of a general nature or relating to the status of this application should be directed to the **Technology Center 2800 receptionist** whose telephone number is **(703) 308-0956**.

10/12/02



Primary Examiner
Alexander O. Williams